

BEST AVAILABLE COPY

Reconsideration of the application is respectfully requested in light of the following remarks:

REMARKS

Claims 1-20 are pending. Claims 1-7, 9-13 and 18-20 stand finally rejected under 35 U.S.C. § 103(a), as being allegedly obvious in light of U.S. Patent No. 6,018,715 to Lynch, in view of U.S. Patent No. 6,374,237 to Reese.

Applicants wish to thank the Examiner for the courtesy he extended during the above-referenced telephonic interview. Applicants' representative has reviewed the Interview Summary contained in the Office Action mailed October 14, 2004, and wishes to point out that the Reese reference (U.S. Patent No. 6,374,237) was also discussed during that interview. The principal arguments presented to the Examiner during the interview are included below.

A. Summary of Arguments

For the purpose of this response,¹ Applicants focus upon the following two reasons that the current §103(a) rejection is improper:

- (1) **Missing Elements**: Neither Lynch, nor Reese appear to disclose or suggest providing a user with personalized information, based in part upon a comparison of the user's profile record with at least two contributor profile records within a database.
- (2) **Improper Combination of References**: There has been provided no motivation to combine the teachings of Reese with those of Lynch (even assuming that Reese were somehow considered to supply the referenced missing claim elements).

¹ This response is provided without waiver of Applicants' previously presented other bases for traversing the current claim rejections.

B. Missing Elements of Lynch and Reese:

Applicants' claimed invention is concerned with providing a user with certain personalized information, based in part upon a comparison of a least a portion of the user's profile record, with at least two contributor profile records residing within a database.

The current Office Action concedes that "Lynch is missing comparing user profile records with contributor profile records" (Office Action at page 4.) However, the current Office Action, as understood, takes the position that these missing claim elements are somehow to be supplied by Reese. (Id.) Applicants respectfully traverse this position, firstly, because the cited portions of Reese do not appear to disclose or suggest these missing claim elements.

Reese discloses a method of searching the Internet, wherein a matching server compares data in an aggregate database to a "user profile" supplied by a user. (Reese, at col. 7, lines 47-52.) However, there appears to be nothing in Reese that discloses or suggests that the aggregate database of Reese somehow includes contributor profile records. Moreover, there is nothing in Reese to suggest comparing a user profile record with at least two contributor profile records. Because these missing claim elements are not supplied by Reese, the combination of Reese with Lynch does not provide a proper basis for an obviousness rejection. See MPEP § 2143.03 ("To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.").

C. Improper Combination of Lynch and Reese.

To establish a *prima facie* case of obviousness under § 103(a), the initial burden is on the examiner to provide some suggestion or motivation to combine prior art reference teachings to form the claimed invention. *E.g.*, M.P.E.P. § 2142 ("When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain

why the combination of the teachings is proper.”). Any suggestion or motivation to combine references to make the claimed invention must be found in the prior art, not in an applicant’s disclosure. *E.g.*, M.P.E.P. §§ 2142, 2143. In this case, there has not been provided any suggestion or motivation to combine the teachings of Lynch with those of Reese.

For both of these reasons, Applicants respectfully submit that the present rejections are improper and must be withdrawn.

Conclusion

In view of the foregoing, each of the pending claims is believed to be allowable. The Examiner is invited to contact the undersigned attorney at (713) 787-1418 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

Henry Pogorzelski

Henry Pogorzelski
Reg. No. 55,543
HOWREY SIMON ARNOLD
& WHITE, LLP
P.O. Box 4433
Houston, Texas 77210-4433
(713) 787-1418

Attorney for Applicants

October 27, 2004

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☐ **FADED TEXT OR DRAWING**
- ☐ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKEWED/SLANTED IMAGES**
- ☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☐ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☐ **OTHER:** _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.